

REMARKS

Claims 1-49 remain pending in the application, unchanged.

The Examiner inquired as to discrepancies between applicant's priority claim and that recorded in the Office records.

The records of the Office are incorrect.

Attached is an Application Data Sheet filed November 18, 2004, which is submitted again for re-entry into the file. (A correction request has also been submitted electronically.) The Application Data Sheet recounts:

**Continuity Information**

This application is a::	Division of
Application one::	09/479,304
Filing Date::	January 6, 2000
Patent Number	

Which is a::	Division of
Application two::	09/172,324
Filing Date::	October 13, 1998
Patent Number	6,064,737

Which is a::	Continuation of
Application three::	08/637,531
Filing Date::	April 25, 1996
Patent Number	5,822,436

Which is a::	Continuation-in-part of
Application four::	08/534,005
Filing Date::	September 25, 1995
Patent Number	5,832,119

Which is a::	Continuation-in-Part of
Application five::	08/512,993
Filing Date::	August 9, 1995 (abandoned)

Which is a::	Continuation-in-Part of
Application six::	08/508,083
Filing Date::	July 27, 1995
Patent Number::	5,841,978

Application Two is also a:: Continuation-in-Part of  
Application seven:: 08/438,159  
Filing Date:: May 8, 1995  
Patent Number:: 5,850,481

Which is a:: Continuation-in-Part of  
Application eight:: 08/327,426  
Filing Date:: October 21, 1994  
Patent Number:: 5,768,426

Which is a:: Continuation-in-Part of  
Application nine:: 08/215,289  
Filing Date:: March 17, 1994 (abandoned)

Which is a:: Continuation-in-Part of  
Application ten:: 08/154,866  
Filing Date:: November 18, 1993 (abandoned)

Application Seven is also:: Continuation-in-Part of  
Application eleven:: PCT/US94/13366  
Filing Date:: November 16, 1994

The present specification is substantially identical to applications one – three above.

Generally speaking, each of the CIP applications referenced above includes all of the subject matter of the parent(s), and adds new material.

In particular, the subject matter that is newly presented in applications one – three, as contrasted with application four, is the text that follows the heading “Errata” at page 83, line 18 of the present specification. (Some of these applications also have a discussion of wireless steganographic systems that is not bodily included in the present specification.)

The subject matter that is newly presented in application four, as contrasted with application five, comprises present Figs. 27 and 29-37; and the text that follows the heading “Method for embedding subliminal registration patterns into images and other signals” at page 76, line 32, up to the “Errata” heading at page 83, line 18 of the present specification.

The subject matter that is newly presented in the application five, as contrasted with application six, comprises present Fig. 28, and the text extending between page 68, line 20, and page 70, line 15 of the present specification.

The subject matter that is newly presented in application six, as contrasted with application seven, comprises present Fig. 27, and the text under the heading NETWORK LINKING METHOD... between page 59, line 24 and page 62, line 23 of the present specification.

The subject matter that is newly presented in application seven, as contrasted with application eight, comprises present Figs. 13-26; the text between page 11, line 20 and page 12, line 8 of the present specification; page 21, lines 17-27 of the present specification; page 34, line 27 to page 35, line 3 of the present specification; page 36, line 1 to page 76, line 30 (excluding page 59, line 24 through page 62, line 23, and page 68, line 20 through page 70, line 15, as noted above).

The subject matter that is newly presented in application eight, as contrasted with application nine, comprises present Figs. 5-12; the text at page 4, lines 15-22 of the present specification; and the text between page 17, line 9 and page 35, line 22 of the present specification.

The subject matter that is newly presented in application ten, as contrasted with application eleven, comprises present Fig. 4; and the text between page 12, line 14 and page 17, line 7 of the present specification.

The subject matter that is newly presented in application seven, as contrasted with application eleven, comprises present Figs. 13-26; page 36, line 1 to page 76, line 30 (excluding page 59, line 24 through page 62, line 23, and page 68, line 20 through page 70, line 15, as noted above).

The Background discussions of the different applications vary in terms of the art and other background information they present. And the priority documents vary in other slighter respects not particularly detailed above.

The rejections under § 112 are respectfully traversed. The cited section provides that an application shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the application regards as his invention.

Thus, referring to the subject matter of a prior claim as an “invention” is believed to be appropriate, and does not introduce an indefiniteness of the sort the Board would affirm as a § 112 violation.

Regarding the rejections under § 101, the law pertaining to this area continues to evolve. Applicants would be willing to cancel the claims rejected on this basis to expedite prosecution, if the other claims were found to be allowable. However, if an appeal of the other claims is necessary, then applicant prefers to leave these claims in the application and give the Board the opportunity to clarify the application of § 101 to claims of this sort.

The withdrawal of the earlier art-based rejections is noted with appreciation.

Claims 1-2, 6 and 9-10 now stand newly rejected under § 103 over Jain (5,284,364) in view of NEKO (webpage poster).

Jain is understood to teach a photo ID card featuring a polarization-altering overlay that conveys additional information readable under the influence of a polarizing viewer.

The Action states, “Jain discloses encoding an image with a steganographic message.” However, this is not strictly true. If there is any steganographic encoding in Jain, it is not “encoding an image” but rather encoding an overlay applied over an image.

Claim 1 particularly highlights a difference with Jain in the last claim clause, which requires “printing the encoded photographic images on a common page.” The images printed by Jain are not encoded. They are pristine. Only after they are printed is any arguably steganographic processing applied. The “printing” is not of “encoded photographic images,” as required by applicant’s claims.

Because the Office has erroneously interpreted Jain, the claims rejected on Jain are not further belabored.

Claims 1-6, 9-16, 29-33, 35-36, 45 and 47 stand rejected over a combination of three references: Noburu (JP 05236424), Barton (5,646,997) and NEKO.

Noburu is understood to teach a device alleged to prevent movie piracy, by embedding hidden information in digital video data.

The Action states:

Noburu discloses encoding an image with a steganographic message capable of being printed (see paragraphs 6 and 14).

However, “capable of being printed” is not a teaching found in Noburu. Indeed – printing involves conversion of digital image data into the analog domain – a conversion that introduces large changes to the data (e.g., by dithering, color gamut limitations of ink, etc., etc.) While Noburu includes some error-correction features, his system is exclusively digital, so these error-correction features are understood designed to cope simply with errors as might occur in the digital realm. Nothing in Noburu teaches (nor suggests) that it is suitable for use in photo printing – as mistakenly alleged by the Office.

Because the Office has erroneously interpreted Noburu, the claims rejected on Noburu are not further belabored.

Numerous of the rejections are posited on combinations of three or four references. The Board’s precedent makes clear its recognition that, as the number of applied references increases, so does the apparent influence of hindsight. Even in the best of cases, rejections premised on three and four references face dubious prospects for affirmance at the Board. These rejections are not the best of cases. (Claims 7, 8, 13, 14, 17, 37-38 all stand rejected based on combinations of four references; the undersigned is unaware of any case in which the Board has affirmed a rejection based on four references.)

This application has been pending over five years. Four non-final actions have been issued. Applicant respectfully suggests that the Examiner conclude this protracted prosecution by allowing claims 1-9, 18-28, 39, 46 and 49; canceling the remaining claims (rejected under § 101) by Examiner's amendment; and passing the application to issue.

Date: March 16, 2006

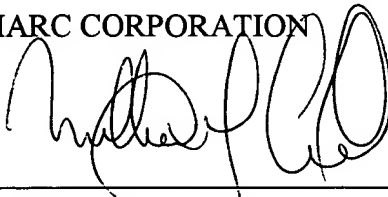
**CUSTOMER NUMBER 23735**

Phone: 503-469-4800

FAX 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION



By \_\_\_\_\_

William Y. Conwell  
Registration No. 31,943